

REMARKS

Per the Office Action of May 29, 2003, all claims pending in the application were rejected. Claims 12-19 were withdrawn due to a previous restriction requirement, leaving claims 1-11 currently pending. Reconsideration of the claims is respectfully requested.

Independent claim 1 has been amended to recite, among other things, that the image is a toner image. Claim 3 has been amended to correct the redundant phrase "heat and temperature" to read "heat and pressure" and to recite that, among other things, the wrap used to transfer the image-receiving resin to the article is dye-free. Applicants submit that this amendment is supported by the specification where dyes are discussed only in conjunction with the image that is created on a separate media. There is no teaching or suggestion that dyes or images of any type be included on the wrap. The use of heat and pressure to bond the receptive layer to the article is disclosed beginning on page 10, line 18. Claim 2 has been canceled as redundant. The paragraph beginning on page 7, line 19 has been amended to correct an obvious typographical error.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,006,502 to Fujimura et al. Fujimura fails to teach the use of toner to create a transferable image as is required by Applicants' amended claims. Applicants respectfully traverse this rejection.

Independent claim 1 has been amended to recite, among other things, that the image is a toner image. Fujimura does not teach the use of toners to create the image to be transferred. All references to the image-producing material refer to “dyes.” The image-producing materials are deposited upon “dyeable resins” and come from “dye layers.” There is no teaching or suggestion that toners would be at all suitable to make the articles suggested by Fujimura. Since the image-producing materials of Applicants’ claimed process differs from the image-producing materials taught by the reference, the instant claims are not anticipated by the reference and the rejection under 35 U.S.C. § 102(b) is traversed.

Claims 4, 5 and 11 are also rejected under 35 U.S.C. § 102(b) as being anticipated by Fujimura. These claims depend from independent claim 3, which has not been rejected as being anticipated by the reference. The novel features of claim 3 are also part of claims 4, 5 and 11. Therefore, claims 4, 5 and 11 must be novel over the Fujimura reference.

Claims 3 and 6-10 are rejected under 35 U.S.C. § 103(a) as being obvious in view of Fujimura et al. Applicants’ submit that the Examiner has failed to establish a *prima facie* case of obviousness and respectfully traverse this rejection.

In order to establish a *prima facie* case of obviousness, there must be a suggestion or motivation to modify the references, there must be a reasonable expectation of success and the reference must teach or suggest all claim limitations. None of these requirements is present when Fujimura is applied to Applicants’ amended claims. Fujimura does not teach or suggest the use of a dye-free wrap as claimed.

The reference has no teaching or suggestion that it would be useful to use a dye-free wrap to transfer an image to an article. Fujimura utilizes a transfer sheet that includes dyes on the same sheet as the image-receiving layer and the adhesive layer. The image is formed by depositing the image-receiving resin on the uncoated article at the same time the image is created. Special equipment would be required to create the image in this fashion. The equipment must be able to hold a three-dimensional article in a position that the image can be created. Multiple passes would be needed to deposit the resin, multiple colors and a protective coat to the article, which the equipment must be capable of handling. The image is therefore created directly on the article.

In contrast, Applicants' image is created on paper using conventional printers that utilize either toner or sublimable dyes. Only a heat press is necessary to apply the image-receiving material to the article, then transfer the image to the image-receiving resin. The use of more conventional equipment makes it more affordable for civic groups, schools, youth organizations and the like to make personalized articles without the purchase of expensive equipment dedicated only to that purpose. Fujimura does not consider using dye-free wraps or other techniques that do not require specialized equipment and therefore does not teach or suggest their use.

There is no reasonable expectation that other ways of transferring an image, such as by using toner, would be successful in the process of Fujimura. The transfer sheet would have to be totally redesigned to find a means of holding toner on the transfer sheet for

deposition on the article with the image-receiving resin. If the image were preprinted so that the toner particles adhered to each other, Fujimura has no teaching or suggestion as to how the image would be transferred to the image-receiving resin. Thus, there is no expectation of success if a dye-free wrap were used in the process of Fujimura.

Finally, assuming arguendo that it were obvious to use a dye-free wrap as suggested by Applicants, not all of the claim elements would be present because there would be no image. Fujimura creates the image to be transferred from the sublimable dyes present on the transfer sheet. Without them, the reference does not teach or suggest an alternate way to create an image suitable for transfer.

Therefore, claim 3 and all claims dependant thereon, are not obvious in view of Fujimura because no *prima facie* case of obviousness has been established. There is no teaching or suggestion that a dye-free transfer sheet or wrap be used. If one were used, there would be no expectation of success because the process would have to undergo too many changes. Finally, without the dyes, there would be no way to create an image using this process.

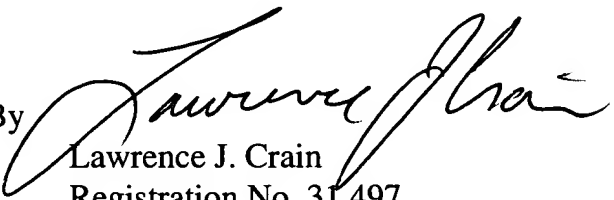
By the above arguments and amendments, Applicants believe that they have complied with all requirements expressly set forth in the pending Office Action. Allowance of the rejected claims is respectfully requested. The Examiner should contact the

undersigned or Applicants' attorney, Lisa M. Soltis, at (847) 724-7500 if a telephonic interview would expedite prosecution, or send correspondence to the address below:

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Respectfully submitted,

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